



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/798,340

03/12/2004

Dwight Allen Merriman

16113-1341007

5600

26192 7590 08/06/2009

FISH & RICHARDSON P.C.

PO BOX 1022

MINNEAPOLIS, MN 55440-1022

EXAMINER

LANEAU, RONALD

ART UNIT

PAPER NUMBER

3714

NOTIFICATION DATE

DELIVERY MODE

08/06/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/798,340	<b>Applicant(s)</b> MERRIMAN ET AL.	
	<b>Examiner</b> Ronald Laneau	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3714

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/13/09 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim reads "... first advertising request based on a prediction of a user response to the candidate advertisements, ..." This is not disclosed in the specification as filed and Applicant is required to provide the exact column and line s where these limitations are disclosed. Although, the Examiner did not have to reject claim 8 since there is a new matter situation, claim 8 will have the same rejection of claim 1 and this limitation will not be considered.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 8-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Graber et al (US 5,812,769).

Graber et al was cited by Applicant in IDS received on 04/07/05.

As per claims 1, 8 and 14, Graber discloses a method for advertising, comprising: contracting with a first affiliate web site to embed a first link to an advertisement server within content of said first web site (see abstract), wherein said first link is sent to a user node in response to a request for said content from said user node to said first affiliate web site (see fig. 1); receiving a first advertising request from said user node based upon said first link (col. 5, lines 55 to col. 6, line 22) ; selecting an advertisement, from among candidate advertisements based upon stored information about said user node and based upon stored information about the candidate advertisements, to send to said user node in response to the first advertisement request (col. 5, lines 25-54; an advertisement becomes an advertisement candidate for selection when a user clicks many times on a particular link or website so it is now a good candidate for selection since the user seems to like this link or website).

As per claim 2, Graber discloses storing information associated with said first advertising request from said user node ; a method for advertising, comprising: contracting with a first affiliate web site to embed a first link to an advertisement server within content of said first web

Art Unit: 3714

site (see abstract), wherein said first link is sent to a user node in response to a request for said content from said user node to said first affiliate web site (see fig. 1); receiving a first advertising request from said user node based upon said first link (col. 5, lines 55 to col. 6, line 22) ; selecting an advertisement, based upon stored information about said user node, to send to said user node in response to the first advertisement request (col. 5, lines 25-54).

As per claim 3, Graber discloses a method wherein the information about the user node comprises information regarding a type of advertisement previously selected by the user, the type of advertisement indicating an interest of the user (when a user clicks on a link, said user expresses interest in the site).

As per claims 9-13, Graber discloses a method wherein the historical user responses are click throughs, and wherein selecting is based on a historical click through rate (col. 1, lines 46-49); a method further comprising identifying a user associated with the request, and wherein selecting an advertisement in response to the request is based on at least one of an identity of a user and a group membership of the user (col. 2, lines 39-60); a method wherein identifying a user comprises resolving identification of an unknown user based on an IP address of the user (all individual computers have a unique IP address related to a particular user); a method further comprising reporting, to an advertiser, information based on the historical user responses to historical advertisement selections involving an advertisement associated with the advertiser; a method further comprising receiving messages regarding historical user responses to historical advertisement selections (col. 1, lines 46-49).

Art Unit: 3714

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-7, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graber et al (US 5,812,769).

As per claims 4-7, Graber does not explicitly disclose a click-through rate and selecting the advertisement based on attribution but it would have been obvious to one of ordinary skill in the art to include information regarding a click-through rate; a method wherein selecting the advertisement from among the candidate advertisements comprises selecting the advertisement based on an expected click-through rate; compile information regarding users belonging to a group of users and attributing the compiled information to a user, wherein selecting the advertisement from among the candidate advertisements comprises selecting the advertisement based on the attribution; target the user based on the historical information regarding the candidate advertisements and the information regarding at least one of the user and a group including the user because it would enhance the way advertising is selected by allowing a user to navigate different sites that are popular and click on them if interested.

As per claims 15 and 16, Graber does not explicitly disclose a method wherein the targeting information includes interest information and wherein selecting comprises identifying a match between an interest of the user and the interest information for the candidate advertisements, wherein the interest of the user is determined based on at least one of the

Art Unit: 3714

information contained in the request for an advertisement and the information about the web page requested by the user; a method wherein the targeting information includes information regarding groups to which the advertisement should be distributed, and wherein selecting comprises determining a group membership of the user based on at least one of information contained in the request for an advertisement and information about the web page requested by the user but it would have been obvious for the same reasons given previously.

### ***Response to Arguments***

8. Applicant has sent no arguments about the previous rejection so claims 1-16 are now rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571)272-6784. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald Laneau/  
Primary Examiner  
Art Unit 3714

rl